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Junji Takenaka

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EXAMINER

FREEMAN, JOHN D

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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#### **ATTACHMENT TO ADVISORY ACTION**

##### Regarding rejections under Double Patenting:

The terminal disclaimer filed on 20 February 2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,802,993 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The rejection is hereby withdrawn.

##### Regarding rejections under 35 USC 102/103:

Applicant argues "the examiner has failed to establish a *prima facie* case of anticipation" (p3). The examiner reiterates that he takes the position that the cured products of Momoda '038 inherently satisfies the strength requirements as presently claimed because said products are the same as presently claimed. Note the courts have held that "a compound and all its properties are mutually inseparable", *In re Papesch*, 315F.2d 381, 137 USPQ 42, 51 (CCPA 1963). Further, attention is drawn to MPEP 2112.01, which states that "products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present.", *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Applicant submits data for consideration in a Declaration under 37 CFR 1.132 filed 20 February 2009.

The examiner finds the data unpersuasive for the following reasons:

First, the examiner notes much of the data provided by Applicant does not overlap in scope with the present claims. Of the data offered, only examples 10, 11, 15, 24, 25, 34, and 35 disclose the required three monomers of the present claims. The other examples use monomers not relied upon for the rejection.

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Second, examples 9 and 26 also include the required three monomers, but data were not provided for them. Applicant states these are “similar” to examples 15 and 25, respectively, but it is unclear what effect the differences in compositions may have on the tensile strength of examples 9 and 26. Therefore, it is unclear if the tensile strengths of all relevant examples in Momoda ‘038 are less than the required 20Kgf. The examiner notes, however, even if these examples do not have a tensile strength in the claimed range, the examiner maintains it would have been obvious for one of ordinary skill in the art to optimize the ratio of monomers to achieve a product with higher tensile strength for the reasons of record.

Third, while the data show examples of containing BPE and TMPT and specific additional monomers (corresponding to Applicant’s (III) polymerizable monomer), the data do not support for the broad disclosure of *any* (III) polymerizable monomer as claimed. Momoda ‘038 discloses many monomers suitable for monomer (A), corresponding to (III) [0021-46]. The identity of the monomer will clearly have an effect on the overall tensile strength, particularly when the monomer constitutes 1-50% of the curable composition [0069].

Fourth, the data provided do not cover the range of values disclosed by Momoda ‘038 that overlap with the presently claimed invention. Although Momoda ‘038 does not disclose examples covering the entire range of disclosed values, “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967).

Regarding rejections over Momoda ‘038 in view of Imura ‘931:

The examiner does not argue that Imura does not disclose the present invention; it is used as a teaching reference. The examiner takes the position that one of ordinary skill in the art would recognize that varying the (m+n) values would result in different properties for the final lens product, and could use Imura as a guide as to what properties would result.

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Regarding rejections over Momoda '038 in view of Geffcken '869:

The examiner takes the position that although Geffcken is silent with regard to the present invention's lens substrate, the teaching reference is evidence that using an adhesion promoting buffer layer between a lens substrate and a hard coating layer is well-known in the art.

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794